

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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In re Patent Application of:  
Kenji Sato et al.

Application No.: 10/574,400

Confirmation No.: 9280

Filed: September 20, 2005

Art Unit: 1614

For: PROTEOGLYCAN ISOLATED FROM  
CARTILAGINOUS FISH AND METHOD OF  
PRODUCING THE SAME

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Examiner: TBA

**REQUEST FOR REFUND**

Mail Stop 16  
Director of the U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicants submit herein a Request for Refund for the above-referenced patent application.

The following charges were applied to Deposit Account No. 06-2375:

04-Oct	10	10574400	HOP03167US0	1642	\$400.00
04-Oct	11	10574400	HOP03167US0	1616	\$360.00
04-Oct	12	10574400	HOP03167US0	1631	\$300.00
04-Oct	13	10574400	HOP03167US0	1633	\$200.00

Applicant has previously paid these fees by check (Appendix A). Applicant subsequently submitted a duplicated set of fees as part of a petition to revive, which was mooted because the original filed application was recovered (Appendix B). These duplicate filing fees and the petition to revive fees were refunded to the above deposit account. Applicant should still be credited for the original filing fee payments which were not

refunded. Thus, the above charges are duplicates of fees previously paid. Applicant requests the Commissioner reverse these charges to the above deposit account.

Applicant is extremely grateful to the Commissioner for this consideration.

Dated: October 9, 2006

Respectfully submitted,  
By ALLEN E. WHITE/  
Allen e. White  
Registration No.: 55,727  
FULBRIGHT & JAWORSKI L.L.P.  
Fulbright Tower  
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(713) 651-5246 (Fax)  
Attorney for Applicant

APPENDIX A

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) CONCERNING A SUBMISSION UNDER 35 U.S.C. 371</b>		ATTORNEY'S DOCKET NUMBER HO-P03167US0
INTERNATIONAL APPLICATION NO. PCT/JP2004/003431	INTERNATIONAL FILING DATE 15 March 2004	U.S. APPLICATION NO. (if known, see 37 CFR 1.5) 2003-077778
TITLE OF INVENTION Proteoglycan Isolated From Cartilaginous Fish and Process for Producing the Same		
APPLICANT(S) FOR DO/EO/US Kenji Sato et al.		
Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:		
<p>1. <input checked="" type="checkbox"/> This is a <b>FIRST</b> submission of items concerning a submission under 35 U.S.C. 371.</p> <p>2. <input type="checkbox"/> This is a <b>SECOND</b> or <b>SUBSEQUENT</b> submission of items concerning a submission under 35 U.S.C. 371.</p> <p>3. <input type="checkbox"/> This is an express request to begin national examination procedures (35 U.S.C. 371(f)). The submission must include items (5), (6), (9) and (21) indicated below.</p> <p>4. <input type="checkbox"/> The US has been elected (Article 31).</p> <p>5. <input checked="" type="checkbox"/> A copy of the International Application as filed (35 U.S.C. 371 (c)(2))</p> <p>a. <input type="checkbox"/> is attached hereto (required only if not communicated by the International Bureau).</p> <p>b. <input checked="" type="checkbox"/> has been communicated by the International Bureau.</p> <p>c. <input type="checkbox"/> is not required, as the application was filed in the United States Receiving Office (RO/US).</p> <p>6. <input type="checkbox"/> An English language translation of the International Application as filed (35 U.S.C. 371(c)(2)).</p> <p>a. <input type="checkbox"/> is attached hereto.</p> <p>b. <input type="checkbox"/> has been previously submitted under 35 U.S.C. 154(d)(4).</p> <p>7. <input checked="" type="checkbox"/> Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. 371(c)(3))</p> <p>a. <input type="checkbox"/> are attached hereto (required only if not communicated by the International Bureau).</p> <p>b. <input type="checkbox"/> have been communicated by the International Bureau.</p> <p>c. <input type="checkbox"/> have not been made; however, the time limit for making such amendments has NOT expired.</p> <p>d. <input checked="" type="checkbox"/> have not been made and will not be made.</p> <p>8. <input type="checkbox"/> An English language translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371(c)(3)).</p> <p>9. <input checked="" type="checkbox"/> An oath or declaration of the inventor(s) (35 U.S.C. 371(c)(4)).</p> <p>10. <input type="checkbox"/> An English language translation of the annexes of the International Preliminary Examination Report under PCT Article 36 (35 U.S.C. 371(c)(5)).</p>		
<p><b>Items 11 to 20 below concern document(s) or information included:</b></p> <p>11. <input type="checkbox"/> An Information Disclosure Statement under 37 CFR 1.97 and 1.98.</p> <p>12. <input checked="" type="checkbox"/> An assignment document for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included.</p> <p>13. <input checked="" type="checkbox"/> A preliminary amendment.</p> <p>14. <input checked="" type="checkbox"/> An Application Data Sheet under 37 CFR 1.76.</p> <p>15. <input type="checkbox"/> A substitute specification.</p> <p>16. <input type="checkbox"/> A power of attorney and/or change of address letter.</p> <p>17. <input checked="" type="checkbox"/> A computer-readable form of the sequence listing in accordance with PCT Rule 13ter.2 and 37 CFR 1.821 – 1.825.</p> <p>18. <input type="checkbox"/> A second copy of the published International Application under 35 U.S.C. 154(d)(4).</p> <p>19. <input type="checkbox"/> A second copy of the English language translation of the international application under 35 U.S.C. 154(d)(4).</p>		

EVB76994379US

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

- a.  A check in the amount of \$ 1,400.00 to cover the above fees is enclosed.
- b.  Please charge my Deposit Account No. \_\_\_\_\_ in the amount of \$ \_\_\_\_\_ to cover the above fees. A duplicate copy of this sheet is enclosed.
- c.  The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 06-2375. A duplicate copy of this sheet is enclosed.
- d.  Fees are to be charged to a credit card. **WARNING: Information on this form may become public. Credit card information should not be included on this form.** Provide credit card information and authorization on PTO-2038

**NOTE: Where an appropriate time limit under 37 CFR 1.495 has not been met, a petition to revive (37 CFR 1.137(a) or (b)) must be filed an granted to restore the International Application to pending status.**

SEND ALL CORRESPONDENCE TO:

Melissa W. Acosta, Ph.D.  
FULBRIGHT & JAWORSKI L.L.P.  
Fulbright Tower  
1301 McKinney, Suite 5100  
Houston, Texas 77010-3095  
(713) 651-5407

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\_\_\_\_\_  
SIGNATURE

Melissa W. Acosta, Ph.D.  
NAME

45,872  
REGISTRATION NUMBER

Application No. (if known): Not Yet Assigned

Attorney Docket No.: HO-P03167US0

## Certificate of Express Mailing Under 37 CFR 1.10

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Airbill No. EV 676994379 US in an envelope addressed to:

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Signature

Melissa W. Acosta, Ph.D.  
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Registration Number, if applicable

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Transmittal Letter to the United States Designated-Elected Office  
(3 pages)  
Application (28 pages)  
Drawings (7 sheets)  
Application Data Sheet (4 pages)  
Oath or declaration of the inventor(s)  
Assignment document for recording  
Preliminary Amendment  
Computer readable Sequence Listing  
Check in the amount of \$1,400.00



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## **Post Office To Addressee**

**Atty Docket No.:** HO-P03167US0

**Reference:** UNIUS/10504601

**Inventor:** Kenji Sato et al.

**Application No.:** Not Yet Assigned

**Filing Date:** September 20, 200

**Title:** Proteoglycan Isolated From Cartilaginous Fish and Process for Producing the  
Same

**Documents Filed:**

Certificate of Express Mailing (1 page) Check in the amount of \$1,400.00

Transmittal Letter to the United States Designated-Elected Office (3 pages)

Application ( 28 pages) Application Data Sheet (4 pages)

Oath or declaration of the inventor(s) Drawings (7 sheets)

Assignment document for recording

Preliminary Amendment

Computer readable Sequence Listing

**Via:** Express Mail: Airbill No. EV 676994379 US

**Sender's Initials:** MWA/dr

**Date:** September 20, 2005

**Atty Docket No.:** HO-P03167US0

**Reference:** UNIUS/10504601

**Inventor:** Kenji Sato et al.

**Application No.:** Not Yet Assigned

**Filing Date:** September 20, 200

**Title:** Proteoglycan Isolated From Cartilaginous Fish and Process for Producing the  
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Application ( 28 pages) Application Data Sheet (4 pages)

Oath or declaration of the inventor(s) Drawings (7 sheets)

Assignment document for recording

Preliminary Amendment

Computer readable Sequence Listing

10/574400

**Via:** Express Mail: Airbill No. EV 676994379 US

**Sender's Initials:** MWA/dr

**Date:** September 20, 2005

JC03 Rec'd PCT/PTO 20 SEP 2005

**FULBRIGHT & JAWORSKI L.L.P.**

VENDOR: 177075 Commissioner for Patents

CHECK NO: 72505

APPR#	INVOICE#	DATE	AMOUNT	DESCRIPTION	VOUCH#
01768	092005/01768	09-20-05	1,400.00	Filing fee - 371 Application (11 claims/1 multi-dependent) (P03167US0)/10504601	10656103

**FULBRIGHT & JAWORSKI L.L.P.**

A Registered Limited Liability Partnership

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Check Date

Amount

Sep 20, 2005

\$1,400.00

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OF Alexandria, VA 22313-1450

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Authorizing Signature

117250511130112581100001290911

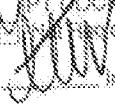
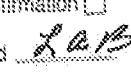
**APPENDIX B**



14 JUL 2006

## UNITED STATES PATENT AND TRADEMARK OFFICE

FULBRIGHT &amp; JAWORSKI, LLP

P.O. BOX 1450  
Docketed  Confirmation   
Initials 1st  Initials 2nd Commissioner for Patents  
United States Patent and Trademark Office  
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Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

Fulbright & Jaworski, LLP  
1301 McKinney, Suite 5100  
Houston, TX 77010-3095

In re Application of  
SATO, Kenji et al.  
Application No.: 10/574,400  
PCT No.: PCT/JP04/03432  
Int. Filing Date: 15 March 2004  
Priority Date: 20 March 2003  
Docket No.: HO-P03167US0  
For: PROTEOGLYCAN ISOLATED ...  
PRODUCING THE SAME

JUL 18 2006

Attorney MWA - Unios  
Docket No. P03167US0  
Action Rec'd Date Due

## DECISION

## ON PETITIONS UNDER

37 CFR 1.10(e) and 37 CFR 1.137(b)

This decision is in response to applicants' "Petition to Accept 371 National Phase Application As Timely Filed," and "Petition For Revival of an International Application For Patent Designating the U.S. Abandoned Unintentionally Under 37 CFR 1.137(b)," filed in the United States Patent and Trademark Office on 11 April 2006.

**BACKGROUND**

On 15 March 2004, applicants filed international application PCT/JP04/03432, claiming a priority date of 20 March 2003. A copy of the international application was transmitted to the Office by the IB on 30 September 2004. The deadline for entry into the national stage in the United States was 20 September 2005.

On 20 September 2005, applicants filed a transmittal letter for entry into the national phase in the United States, accompanied by the basic national fee and a declaration of the inventors.

On 29 March 2006, applicants filed a petition under 37 CFR 1.10(e), accompanied by copies of what applicants claim was submitted on 20 September 2005.

On 03 April 2006, applicants filed a petition under 37 CFR 1.137(b), accompanied by a second payment of fees.

**DISCUSSION**

Applicants state that the 20 September 2005 papers sent to the Office were lost and that the Office has no record of the documents other than the cashed check. Applicants are mistaken. The 20 September 2005 papers are present in the file. The application is not abandoned. Applicants' petition to revive fee and duplicate national fees paid 03 April 2006, will be refunded to deposit account no. 06-2375, as authorized.

**CONCLUSION**

For the reasons set forth above, the petitions under 37 CFR 1.10(e) and 37 CFR 1.137(b) are **DISMISSED AS MOOT**.

This application is being referred to the National Stage Processing Branch of the Office of PCT Operations for further processing. The application has a 35 U.S.C. 371 (c)(1), (c)(2) and (c)(4) date of 20 September 2005.

*Erin P. Thomson*

Erin P. Thomson  
Attorney Advisor  
PCT Legal Administration

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